REMARKS

In response to the Office Action of July 15, 2003, Applicant hereby provides the following remarks.

The Examiner has rejected claims 1-7, 11-22 and 28 as being unpatentable over Liff et al. in view of Ahlin. It is presumed that the Examiner is referring to U.S. Patent No. 6,219,587, as the cited number is for Liff et al.

In analyzing the obviousness rejection, Applicant believes that it is important to understand the fundamental functions of the prior art which the Examiner is relying upon. Liff et al. teaches a drug dispensing system in which a plurality of bins. Each bin stores a particular variety of medication. (Abstract). Thus, when a user enters the appropriate information, a container of the medication from a particular bin is dispensed. A label is also printed for the patient. Thus, for example, a container of penicillin is dispensed in response to the input of certain information. A label is printed for the patient and the prescription is then filled. That container, however, is not a prescription filled for a particular individual until the label is attached.. Thus, only high volume medications would be dispensed from such a machine.

Ahlin, in contrast, teaches an automated system, functionally similar to Liff et al., in which various medicines are placed into a patient bin. (In other words, Liff et al. could be used to fill the bin.) The patient bin is then manually carried to the patient, where it given by a nurse or other health car professional after scanning to ensure that the medications are correct. (Applicant objects to the characterization of the small containers which are carried to the patient as being a receiving slot, as they

are not part of a dispensing portion disposed in communcation with a patient interface and a controller as set forth in the claim, nor would such devices be readily usable in the Liff et al. configuration.

Furthermore, if one where to combine the teachings of Ahlin with that of Liff et al., one would simply get the addition of a bin which is filled with several different medications and then carried to the patient. This is not the claimed invention. Rather, the claimed invention allows all of a patient's medications to be placed into a receiving slot. The medication is then automatically dispensed to the patient at a convenient time and in response to input from the patient.

In combining the references, the Examiner has mistaken Applicant's invention. Specifically, the basis for the Examiner's argument is that "it would have been obvious to one of ordinary skill in the art to modify the method of Liff with the teaching of Ahlin to have all medication dispensed into one receiving slot in response to information correlated with the patient." Office Action page 3-4 (emphasis added). Applicant, however, does not teach dispensing the medication into a receiving slot in response to information about the patient. To the contrary, the claimed invention requires that the controller dispense the medication which is already in the receiving slot through the receptacle. Applicant has amended the claim to eliminate any future possibility of confusion.

There is simply nothing in Ahlin which would suggest a modification to Liff et al. which would fall within the scope of the claim. To the contrary, Ahlin repeatedly teaches away from such a modification to Liff et al. Liff et al. specifically teaches that each bin stores one particular type of medication (Abstract, Col. 5, l. 45-50; Col. 6, l. 13-35). Ironically, Ahlin uses a system functionally similar to Liff et al. to fill the patient bins 32 (see dispenser 26). The patient bins are then manually

transported to the patient, where medical personal again confirms that the medication is proper. (Alhin, Col, 8, lines 23-41.) Neither of the patents teach storing all the medication for a particular patient in a single receiving slot and then dispensing all of the medication through a patient interface portion.

Further, Applicant objects to the office action in that the rejection picks and chooses between aspects of the prior art. As noted above, both Ahlin and Liff teach using a machine dedicated bins to dispense a particular type of medication. To selectively chose some aspects of Ahlin to modify Liff without considering the contra teachings of Ahlin constitutes hindsight reconstruction.

> The PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted). In establishing a prima facie case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. While Applicant admits that virtually every element of a claim may be found somewhere in the prior art, this is not the test to determine whether the prior art renders the invention obvious. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

When the totality of the teachings of Liff et al. and Ahlin are considered, one skilled in the art would not formulate a system which automatically dispenses one or more filled prescriptions to a patient from a single receiving slot. Both pieces of prior art teach away from such a system, and Ahlin specifically teaches the need to cross-check the plurality of medications which are manually carried to the patient. Thus, Applicant respectfully submits that claim 1 and all claims depending therefrom are in condition for allowance.

With specific reference to claim 7, neither patent teaches automatically dispensing a plurality of different medications for a single patient. To the contrary, Ahlin teaches that a medication professional should cross-reference the medications prior to giving them to the patient. (Col. 8, lines 23-41.

Turning now to the rejection of claims 8-10, Applicant respectfully requests reconsideration of the rejections. Applicant understood the claim to require each receiving slot to have its own door. It is apparent, however, that the Examiner considered a single door to be within the scope of the claim. The amended Claim 8 requires at least one door disposed adjacent each receiving slot for controlling passage of medication out of that receiving slot. Halverson, in contrast, as a single door which controls access to a large number of trays 52. Thus, the additional of Halverson does not render the claim obvious. To the contrary, Halverson teaches a vending machine-like dispenser and suggests that each tray contains a particular type of medicine. Thus, not only does Halverson not suggest the subject matter of claim 8, it actually teaches away from the combination regarding claim 1, as one skilled in the art considering all three patents would not be lead to the use of receiving slots for all of the medicine for a single patient.

With respect to claim 9, Halverson does not teach one door for controlling placement of the medication in an a separate door for allowing medication to be removed. Therefore, claim 9 is allowable.

With respect to claim 10, the door of Halverson does not control release of the medication from the receiving slot.

With respect to claim 12, Liff et al. does not track the patient's medication within the receiving slot, as it is not any particular patient's medication until it is dispensed. Likewise, it is not tracked in such a manner in Ahlin until it goes into the patient bin. At that point, however, it is no longer in the dispenser.

With respect to claim 16, Neither Liff et al. and Ahlin teach labeling the medication prior to it being dispensed from the automated dispenser. Rather Liff et al. provides labels after it is dispensed. Applicant is unable to find any teaching an Ahlin that the medicine is labeled for the patient. Rather it appears from the sections cited by the Examiner that the existing bar codes are simply correltated to ensure that the right medicine is delivered to the right patient bin, which is then manually carried to the patient. This does not meet the limitations of the claim.

With respect to claim 18, the Liff et al. system does not use prelabeled medication as required by the claim. To the contrary, in Liff et al. the configuration of the dispensers would substantially prevent such a method of dispensing because one cannot tell when patients will arrive to claim their medicine. Thus, Liff et al. contains preloaded dispensors and the label is applied after the medication is dispensed. In a self-service configuration like applications, such a configuration would be

unacceptable, as the patient could easily mislabel his various medications, labeling his cardiac medication as penicillin and vice-versa.

Applicant has also been unable to find support for the Examiner's position regarding Ahlin. Applicant's reading of Ahlin is that the medications are simply bar coded and that the bar coded medications are assigned to the bar coded patient bins. While such a system would work in a hospital, it could not safely be used to dispense medication directly to the public. Thus, Applicant submits that the art does not teach the subject matter of claim 18.

With respect to claim 19 and 20, Applicant respectfully disagrees with the Examiner. In Liff et al. the medication is not correlated to the patient prior to dispensing. Which container of medication will go to a patient is dependent on when that patient accesses the dispenser. If one were to open that dispenser, one could not correlate any of the medication with a particular patient.

Likewise, regarding claim 21, while Applicant appreciates the argument regarding the nurse dispensing multiple medications, the nurse does not dispense the medication in response to input of data correlated to the patient. Furthermore, the nurse is not the dispenser - which the claims require to have the medicine loaded therein. Thus, claim 21 is not taught by the prior art.

Regarding claim 23, Applicant again objects to the manner in which the prior art is selectively combined. Neither Halvorson nor Liff et al. teach the method set forth in claim 23 prior to dispensing of the medication. Halvorson suggests that the machine is loaded like a vending machine. Thus, no particular container of medication is associated with any patient until it is dispensed. Liff et al. teaches the same concept. Combining the two does not achieve the claimed invention.

With respect to claim 29, Applicant was unable to find support in the cited portions of Halvorson for the conclusions drawn by the Examiner. Furthermore, none of the patents teach transporting prefilled prescriptions to local pharmacies.

With respect to claims 33 and 36, none of the patents teach filling the prescription, disposing the filled prescription in a dispenser and then dispensing the medication to the patient in response to input correlated with the patient. While the Examiner attempts to pull bits and pieces from the different references, none teaches dispensing filled prescriptions to the patient. Rather, the teach either dispensing generic containers which are then given to the patient or dispensing to medical personnel.

In light of the above, Applicant respectfully submits that the claims are in condition for allowance. Should the Examiner determine that any additional adverse action is necessary, Applicant requests an Examiner's interview be held with the Examiner and the Primary Examiner so that such matters may be resolved as expeditiously as possible.

Dated this 14th day of October, 2003.

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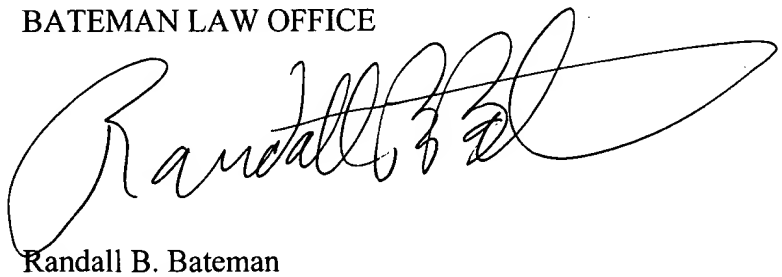

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